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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,961	03/26/2004	Clifton A. Alferness	11998.5USC7	7914

7590 08/24/2005

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EXAMINER

GILBERT, SAMUEL G

ART UNIT

PAPER NUMBER

3736

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/809,961	ALFERNESS ET AL.
	Examiner	Art Unit
	Samuel G. Gilbert	3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 May 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 18-52 is/are pending in the application.
- 4a) Of the above claim(s) 39-52 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 18-36 and 38 is/are rejected.
- 7) Claim(s) 37 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Election/Restrictions

Newly submitted claims 39-52 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in a materially different surgical procedure such as hernia repair or urinary incontinence sling procedure.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 39-52 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 33 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

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was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 33 “elongated members include bends adapted to at least partially straighten as the jacket expands” is not set forth in the specification. Nothing in the specification sets forth that fibers shown in figure 6 include bends or that the bends will at least partially straighten as the jacket expands.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-36 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Sutton(5,224,363). Sutton teaches a sleeve, column 3 line 34, made from a knit metal, column 3 line 25, including stainless steel, column 2 line 9. The examiner is taking the position that all knit material has directional expansion properties and therefore are expandable. The sleeve is capable of performing the recited functional language set forth in the claims. The sleeve could be adjusted by gathering excess material and securing the excess with sutures.

Claim 19 – stainless steel column 3 lines 41-58.

Claim 20 – the sleeve is knit, column 3 line 57.

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Claim 21 – knit inherently provides a differential stretch as claimed, the first and second axis can be defined in whatever direction provides the claimed differential stretch.

Claim 24 – a plurality of fibers can be used, column 3 lines 52.

Claim 25 - the knit inherently includes open areas or there would be no need for fluid impermeable coating –10-.

Claim 26 – coating 4 provides a lining.

Claim 27 – coating 4 is a polyurethane or vinyl and polyurethane is an anti-fibrosis material.

Claim 28 – element 4 is a coating.

Claim 29 - coating 4 is a polyurethane or vinyl and polyurethane is an anti-fibrosis material.

Claim 34 – stainless steel is a metal alloy.

Claim 35 – the knit sleeve is inherently collapsible in that it can be made flat.

Claim 36 – a forearm sleeve would be open at both ends.

Claims 30-33, and 38 – are all directed to the size of the sleeve in relation to the heart around which it is to be placed. It is the examiner's position that a forearm sleeve for use on an adult male working in a meat processing plant would be capable of fitting about a heart of a particular size, because an infant heart would be smaller than a forearm sleeve and an adult heart would be larger than a forearm sleeve. However, at some point in the development of the heart it would fit as claimed within the forearm sleeve.

Allowable Subject Matter

Claim 37 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 5/3/2005 have been fully considered but they are not persuasive. The applicant Sutton is not capable of being used as claimed because of the size of the device. It is the examiner's position that a forearm sleeve for use on an adult male working in a meat processing plant would be capable of fitting about a heart of a particular size, because an infant heart would be smaller than a forearm sleeve and an adult heart would be larger than a forearm sleeve. However, at some point in the development of the heart it would fit as claimed within the forearm sleeve.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Gilbert whose telephone number is 571-272-4725. The examiner can normally be reached on Monday-Friday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eleni Mantis-Mercader can be reached on 571-272-4740. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Samuel G. Gilbert
Primary Examiner
Art Unit 3736

SGG
8/21/2005